

REMARKS

Claims 20-23 and 38-63 are pending, with claims 20, 38, 39, and 49 being independent. Claims 57-63 have been added. Applicant requests reconsideration and allowance of claims 20-23 and 38-63 in view of the attached amendment and the following remarks.

The Examiner has rejected claims 20, 21, and 38 as being anticipated by, or in the alternative, as obvious over U.S. Patent No. 5,163,433 issued to Kagawa, and claims 22 and 23 as obvious over Kagawa. Applicant traverses these rejections.

Regarding claims 20-23, independent claim 20 recites, among other things, "inserting into said cavity a device for cutting and detaching said tissue, said device being driven by coupling to a motor" (emphasis added). As explained in Applicant's Amendment in Reply to Office Action, filed March 22, 2004 ("Applicant's Previous Reply"), Kagawa fails to describe or suggest at least the claimed insertion of a device driven by coupling to a motor. On page 3 of the Final Rejection, the Examiner maintains the previous rejection of claim 20 on the basis that "a motor is a device that converts any form of energy into mechanical energy," and that the "KAWAGA device is a device that receives electrical energy via piezoelectric elements (10a, 10b) to convert into mechanical energy (ultrasonic vibration of probe 3) by coupling to the other parts of the device." However, as stated in Applicant's Previous Reply, the Kagawa device, as characterized by the Examiner, is itself a motor, rather than being a "device being driven by coupling to a motor," as recited in claim 20. It is the ultrasonic vibration of probe 3 of Kagawa that apparently cuts and detaches tissue. Probe 3 of Kagawa is part of the Examiner's "motor," not a "device being driven by coupling to a motor," as recited in claim 20. Applicant continues to traverse the Examiner's characterization of the regulation of pressure in Kagawa. For at least these reasons, Applicant respectfully submits that claim 20, and its dependent claims 21-23, are patentable over Kagawa.

Regarding independent claim 38, that claim recites, among other things, "discharging fluid with detached tissue along a first path, and discharging substantially only fluid along a second path completely separate from said first path" (emphasis added). As explained in Applicant's Previous Reply, Applicant respectfully submits that Kagawa does not teach a first

path which is completely separate from a second path, as claimed, but rather, Kagawa discloses paths 26 and 21 which are connected at suction tube 16. See, e.g., Kagawa at Fig. 1. On page 3 of the Final Rejection, the Examiner maintains the previous rejection of claim 38 on the basis that paths 21 and 26 are completely separate before they connect at suction tube 16. However, as a result of the connection at suction tube 16, paths 21 and 26 are not completely separate. The Examiner alternatively asserts that "one could use separate conduits to connect paths 21 and 26 without any significant effect on device performance." However, Kagawa teaches away from this proposed modification by stating that "[s]ince the first and second suction passages 21 and 26 meet at a proximal end side, if the first suction passage 21 is clogged, then an increased amount of suction is involved and hence, it is possible to prevent a living tissue, for example, from being sucked into the distal end of the probe 3." See Kagawa at col. 7, lines 40-51. For at least these reasons, Applicant respectfully submits that claim 38 is patentable over Kagawa.

The Examiner has rejected claims 39-42, 44-52, and 54-56 as being anticipated by U.S. Patent No. 5,449,356 issued to Walbrink, and claims 43 and 53 as obvious over Walbrink. Applicant traverses these rejections.

Independent claim 39 recites, among other things, "inserting a cutter into a lumen of an endoscope through a valve of the endoscope," and independent claim 49 recites, among other things, "inserting a cutter into a distensible organ through a shut-off valve of an endoscope" (emphasis added).

As explained in Applicant's Previous Reply, Walbrink fails to describe or suggest inserting a cutter through an endoscope. In the Final Rejection, the Examiner maintains the previous rejection on the basis that probe 20 of Walbrink is equivalent to the claimed endoscope. To that end, the Examiner cites a definition of an endoscope as an "instrument for examining visually the interior of a bodily canal or hollow organ." However, even accepting the Examiner's definition of endoscope, probe 20 of Walbrink is not an endoscope because it is not used to visually examine interior organs of a body. Rather, Walbrink describes an endoscope in the form of a wand-like device 38 attached to a video camera and a light source for visually viewing interior organs so that a surgeon can manipulate a separate surgical probe 20. See, e.g.,

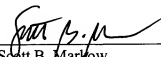
Walbrink at col. 5, lines 60-68. As shown in Figure 1 of Walbrink, the probe 20 is not inserted through the wand-like device 38, but rather is inserted directly into abdominal wall 26. For at least these reasons, claims 39 and 49, and their dependent claims are patentable, over Walbrink.

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

Enclosed is a \$550.00 check for excess claim fees and a \$450.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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